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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,651

10/30/2003

Bennett Johnston

899.03

3757

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11/14/2007

EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,651

Applicant(s)

JOHNSTON, BENNETT

Examiner

William M. Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,23-25,27,28,30-32,34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,23-25,27,28,30-32,34 and 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

- DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 21-25, 27, 28, 30-32, 34, 36-42 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of claims 21, 23, 25, 27, 28, 30, 32, 34, 40 and 41 cannot be determined. Where the printed direction has been amended to described it as being one "requiring performance...that contains objective, not personally unique information", "subjective impressions and personal feelings" and "have no commonly known association and no personal significance to the game players", there is no way to determine what type of direction is meets such functional limitations. For example, a direction pertaining to the city of New York may be intended to be based on objective information. However, a response on NY city could also be based on personal information a person has from living there or from a visit. As such, it is impossible to determine what type of printed indicia on the cards one wishes to include. "Presently" on ln. 5 of claim 44 appears to be a typo.

Claims 39 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

Art Unit: 3711

had possession of the claimed invention. The specification does not disclose moving the marker of another player when it occupies an intersection.

Applicant remarks that claim 39 calling for "moving the marker of another player when the game player occupies the at least one intersecting position" is shown at {0078} of '239 publication. However, this paragraph discusses players required to "switch paths" and does not discuss "intersecting positions as called for in the claim. As such this grounds for rejection remains.

Exchanging cards as called for by claim 44 is not set forth in the specification as originally filed.

Claim Rejections - 35 USC § 103

Claims 21-25, 27, 28, 30-32, 34 and 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry 4,714,255 in view of Alexander 6,279,909 as set forth in the previous office action;

As to claims, Henry shows a game board of intersecting first and second paths in combination with a plurality of collections of instructions in fig. 4 that stimulate the human memory. Inherently the player uses all of his memory systems, short-term, semantic and episodic memory systems, available to him based upon his individual ability in order to answer the question. Alternatively, while Henry factual trivia question, Alexander teaches that a mix of tasks, questions and actions can be in a trivia type game. To have added tasks such as that taught by Alexander would have been obvious in order to make the game more interesting to the players by offering a more variety of questions. With respect the applicant's use of the term "instructions" per se, broadly it has been held that the addition of instructions for how to use a device cannot impart patentability. See *In re Ngai* (5/13/04)(Michel, Garjarsa, Linn)(per curiam).

Further while Henry and Alexander fail to discuss the science behind the memory skills use in the answering of the game tasks, it has been clearly held that a property or a scientific explanation of the prior art's functioning does not negate the fact that the prior art inherently possessed the claimed element. "Insufficient prior understanding of inherent properties of a known composition

Art Unit: 3711

does not defeat a finding of anticipation" *Atlas Powder Co. v. Ireco Inc.*, 19 F.3d 1342, 51 USPQ 2d 1943 (Fed. Cir. 1999).

With respect to paragraphs 4 and 5 of applicant's argument, they do not discuss limitations that are present in the above claims and are considered moot.

As to claims 20, 28, 32 and 40, such are considered apparatus claims. Alexander teaches a plurality of sets of cards 24, each of which bears a unique direction such as a question or a task to perform. The remaining limitations recited in the new apparatus claims of "the cards may be drawn..." and "the performance of each unique task..." fail to further limit the claimed invention by distinguishing over the applied art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). As to claims 22, 29, 33 and 42, shown by Henry is a playing surface 1 marked with a plurality of indicia with a first path 2 and a second path 4 and markers in fig. 2. As to claim 23, 30 and 41, taught is a third set of cards in Alexander's 24. As to claims 24 and 31, Henry shows a plurality of intersections 20 on the playing surface that the players "may occupy". With respect to claim 25, no "means for" are recited and such is not interpreted as invoking 35 USC 112, sixth paragraph limitation requirements into this claim. As such the functional limitations as to what how the structure is to be used in playing the game to "require responses associated primarily with a single second human memory system" and "call for a second type of response" relates only to the printed matter and fails to distinguish over the applied art. More specifically to claim 25, the first and second "collection" is considered shown in the cards of Alexander in the cards as discussed above with respect to claim 20. What the "first directions call for" and how they "may be presented to game players" relates only to the intended method of use or play that fails to further distinguish this apparatus from the applied art. As to claim 26, the recited "game display" is considered to be the board 1 as set forth in claim 20 above with its first and second paths 2 and 4 respectively. Claim 27 is shown in the third cards as set forth above with respect to claim 23. In claims 34 and 43, Alexander teaches using different types of cards 24a with different types of directions that calls for a player to retrieve information from memory using the first human memory system. Further shown is a second direction 24b that allows a person to answer using a second human memory system. As to claim 35 and 36, fairly taught is first and second paths as set forth above with respect to claim 22. In Henry, the marker is moved along a path after responding to a question as called for in claims 37 and 38. As to claim 39, it is known to game to remove another marker of a player when it occupies the same space.

With respect to the rejection set forth above, it can be summarized that the contribution to the art of trivia game from Henry is that of the game play surface with 1st and 2nd intersection paths. Alexander contributes combining several different type of questions requiring different types of responses in a trivia game. Applicant has amended the claims to now recite "requiring performance of a task...that contains objective facts" or "subjective impressions and personal feelings". Here in the apparatus claims, these limitations are considered functional of how the players are to play the game and not in any way positively limiting the "printed direction" on the cards. The limitation to requiring is related to rules and intended play and is not considered to

Art Unit: 3711

be a structural limitation that pertains to the indicia on the cards. Note while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). With respect to claim 44, exchanging cards from a first player asking the question to a second player answering the question if the second player answers correctly is considered old and well known in games where players retain the cards that they answered correctly in order to collect the cards to determine the winner of the game.

Applicant's arguments filed 8/18/07 have been fully considered but they are not persuasive.

In applicant's remarks, he initially states that the combination of Henry and Alexander is improper because they relate to "vastly different ways of making game play interesting. In response, applicant is reminded that the claims are interpreted in view of the prior art of games as a whole. Even though games may have different themes and modes of play they can be relied upon for their contribution of teachings in the art of games.

Applicant incorrectly states that "recently, the U.S. Supreme Court has rejected" the TSM test. Instead, the Court reaffirmed *Graham v. John Deere*, and stated that the TSM test was "overly rigid and formalistic." It emphasized that the prior art is not limited to just the references being applied, but also includes the understanding of one of ordinary skill in the art.

Applicant's subsequent remarks amount to the allegation that he claims as not amended are patentable. The examiner has set forth above in each grounds for rejection how each amended limitation is being treated or where they found in the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

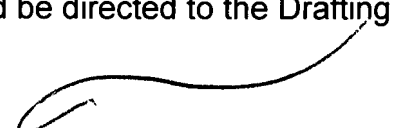
For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

Art Unit: 3711

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE
PRIMARY EXAMINER